# WHAT IS PATENTABLE AS A DESIGN?

A paper read April 29, 1915, before the Examining Corps of the United States Patent Office

BY

H. I. HOUSTON,
First Assistant Examiner of Trade-Marks and Designs,
U. S. Patent Office.

WASHINGTON, D. C.
1915

THE LAW REPORTER PRINTING COMPANY, WASHINGTON, D. C.

# What is Patentable as a Design?

By

H. I. HOUSTON,

First Assistant Examiner of Trade-Marks and Designs,
U. S. Patent Office.

---

The purpose of this paper is to point out the principal guide-posts which bound and define the field within which the applicant may, under the law, seek and secure the grant of a design patent. In so far as is practicable, the discussion will be limited to those phases of the question wherein the controlling principles differ materially from those relating to mechanical patents.

Briefly described, a design consists of the visual characteristics displayed by an object. Designs may be divided into two general types; one existent in the contour or outlines of an article, the other in a decoration applied to the surface thereof. The first type is illustrated in the shape of a teacup, the second in the pattern on a piece of wall paper as defined by the contrasting colors. A single object may embody one or both forms of design, and if both, they may be aggregated or combined.

The elemental factors by which the patentability or nonpatentability of a design is determined are disclosed in section 4929 of the Revised Statutes, which reads as follows:

> "Sec. 4929. Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees

required by law and other due proceedings had, the same as in cases of invention or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor."

Upon a comparison of the provisions of this section of the statute with those of section 4886, which specifies the principal prerequisites to the grant of a mechanical patent, perhaps the most striking difference to be noted is that of the subject-matter to which the invention may relate. Designs for articles of manufacture alone are entitled to protection. A design for a machine is therefore not proper subject-matter under the statute for the grant of a patent. (*Ex parte* Adams, 1898 C. D., 115; *Ex parte* Steck, 1902 C. D., 9.)

Patents are not granted for designs in the abstract, because of the limitation of the statute to designs for articles of manufacture. (*Ex parte* Gerard, 1888 C. D., 37; *Ex parte* Adams, 1898 C. D., 109.) Moreover, a definite article must be selected and illustrated by the applicant. (*Ex parte* Whyte, 1871 C. D., 304.)

By the recent decision of *Ex parte* Fulda (194 O. G., 549) this practice has been somewhat modified in the case of surface ornamentation, it being considered sufficient compliance with the statute to require the applicant to specify that the design is for an article of manufacture, without designating or illustrating a particular article.

It is the settled practice of the Office at the present time to require the applicant to confine his disclosure to a single form of the design, and not to permit the illustration or description of any modification or variation, it being left to the courts to determine the essential features or gist of the invention. (*Ex parte* Hill & Renner, 1898 C. D., 38, and cases referred to therein.)

The complete article embodying the design must be illustrated even though the novel feature or features may not embrace the whole article. (*Ex parte* Parker, 1897 C. D., 73.) An exception is made in certain cases of surface ornamentation falling within the ruling of *ex parte* Fulda (*supra*).

The most significant word found in the statutes relating to designs is the word "ornamental." It defines

an attribute which must be existent in every design which is to successfully weather the storms of the Patent Office or of the courts. Besides, it is the chief guide-post separating the field of the design patent from that of the mechanical.

When used in relation to designs, the term "ornamental" designates that which finds favor in the eye of the observer by its appeal to the esthetic emotions. An article may be "ornamental" because of beauty in outline or in surface ornamentation, or because of the proper balancing or harmonious arrangement of its parts. Objects which are ludicrous, grotesque, or fantastic, if they embody artistic merit, fall within the term "ornamental" as here used.

The fact that an article is not crude or unsightly is not sufficient in itself to render it "ornamental" within the meaning of the statute. Neither does it present proper subject-matter for the grant of a design patent merely because there is something new about its shape whereby it can be distinguished from other articles. (Wright *vs.* Lorenz, 1902 C. D., 370.) It should positively appear that the object possesses certain characteristics which render it distinctly attractive to the eye of the observer. In some cases the presence of such ornamental features is best determined by the effect produced.

In the case of certain classes of articles, such as cut glass, jewlery, vases, and silverware, where the primary object sought is the production of an article which shall present a pleasing appearance, but little trouble is experienced. A different situation, however, is presented by those objects which in their appearance are preeminently suggestive of mechanical utility.

In the latter case it would seem to be a salutary precaution to scrutinize the design closely and to consider it the subject of a valid patent only when found to possess a feature or features distinctively ornamental. As suggestive of such practice, attention is directed to the case of *ex parte* Bettendorf (1907 C. D., 79) wherein the Commissioner refused to grant a patent for the side frame of a car truck, quoting with approval the following language from the decision of the Board of Examiners-in-Chief:

> "We are of opinion that its attractiveness to such men lies wholly in the apprehension of its

utility, in its superior adaptation of its shapes to utilitarian ends. They see that the design is compact lengthwise by reason of the location of the journal-boxes against the end of the frame. They see that it is lowered by making the inverted-arch tires farther down from the bearings than the upper tires are distant from those bearings. So made the side bar is not only lower but is stronger. They see that a minimum of weight is attained by skeletonizing the side bar by two openings near its ends and they see that in doing that the old upper truss and lower truss and the old guides are made with edge flanges which, as is well known, add strength to them. They also see here and there cross-webs, which, they well know, also add to the strength of the parts on which they are made and with which their ends are connected. All this makes the design attractive to them as practical men in the art.

"But we are of opinion that this utilitarian attractiveness is far from ornamentation. We find nothing beautiful or esthetic in the structure."

To the same effect are the rulings in the cases of *ex parte* Nickel and Crane (1904 C. D., 135); and ex parte Harthshorn (1903 C. D., 170).

A failure on the part of the Patent Office to follow the practice indicated is apt to lead to the grant of patents of the character considered in the case of Rose Mfg. Co. *vs.* E. A. Whitehouse Mfg. Co. (201 F. R., 926). The patents in controversy related to vehicle number plate supports, and in holding them invalid the court said in part:

"The designs of the design patents in suit are for the most part alike. No. 41,389 differs, however, from No. 41,388 in having braces which unquestionably strengthen the arm, to which the number plate is attached. It is not only apparent that this is their function, but it is also established to be such by the evidence. Indeed, every feature of these patents is mechanical and functional, and not ornamental. Even ordinary rivet heads are made to appear as beautiful circles in this scheme of ornamentation. If, moreover,

> the braces or supports of patent No. 41,389 were intended for ornamentation, they apparently failed in their mission, but, if otherwise, then every piece of mechanism can, with the aid of photography and the machinery of the Patent Office, be readily crystallized into a design patent."

Because of the diverse character of the subject-matter involved, but little information would be gained by an enumeration of the various articles which have been held to lack artistic merit sufficient to render them ornamental within the meaning of the statute. There is a class of cases, however, to which reference should be made. They relate to articles which are often referred to as intended for obscure use. In the case of Rowe *vs.* Blodgett (112 F. R., 61), wherein a design patent for a horseshoe calk was held invalid because not ornamental, the court said:

> "Design patents refer to appearance, not utility. Their object is to encourage works of art and decoration which appeal to the eye, and the esthetic emotions, and the beautiful. A horseshoe calk is a mere bit of iron or steel, not intended for display, but for an obscure use."

Other articles which have been held not ornamental because intended for obscure use are, a washer for thill couplings (Bradley *vs.* Eccles, 126 F. R., 945); a ribbon spool for use in typewriters (Wagner Typewriter Co. et al. *vs.* F. S. Webster Co., 144 F. R., 405); an insulating plug for electric line supports (Williams *vs.* Syracuse & S. R. Co., 161 F. R., 571).

In order to sustain a patent grant, it is not sufficient that the design be ornamental. Its creation must result from the exercise of the inventive faculty. Not only is this necessary to bring it within the provisions of section 4929 of the Revised Statutes, but also to bring it within the constitutional provision whereby Congress may lawfully grant a limited monopoly to its creator as an inventor. In *ex parte* Knothe (1903 C. D., 42), the Commissioner said:

> "A new and ornamental design will be found in an article of manufacture when there can be

found in such article a new appearance created by inventive process and serving the purpose of embellishment. Such new appearance may be superficially applied or it may rest more or less deeply in the structure of the parts, but it must be a creation of inventive genius, accomplishing the purpose of ornament and not used for its functional value. It will be found, weighed and valued by the test of ornament."

In some of the decisions, statements are found to the effect that a lower order or degree of invention may support a design than is necessary in case of a mechanical patent. I am unable to find a sound basis for this assumption. An exercise of the creative imagination is just as essential to invention in the field of art as in the field of mechanics, and if this mental ingredient be not present in the resultant product no protection, under the statute, is accorded to its creator. There is apparently no warrant for assuming that those engaged in the production of beautiful and artistic effects are less gifted in mental acumen than those interested in the field of mechanics.

Considerable difficulty is often experienced in determining the presence or absence of invention in a mechanical device. To a greater extent is this true in the case of designs because of the character of the subject-matter involved, and also because but few principles have been worked out to aid in its determination.

A design made up of well-known ornamental features does not involve invention unless they combine to produce a new and distinct ornamental effect. Otherwise it is a mere aggregation and unpatentable as such. (Northrup *vs.* Adams, 1877 C. D., 322.)

The choice of a particular color or colors or the substitution of one color for another contributes in no way to the patentability of a design. (*Ex parte* Weinberg, 1871 C. D., 244; *Ex parte* Traitel, 1883 C. D., 92.)

As to size and material, the Court of Appeals of the District of Columbia in the case of Tyler *vs.* St. Amand (1901 C. D., 301) quoted with approval from the decision of the Acting Commissioner of Patents in part the following:

"The material of which the article is made and

its size are immaterial in design cases, since designs relate merely to form or appearance."

It has repeatedly been held that the adaptation to an article, of a design, old in another and even non-analogous art, does not involve invention. (*Ex parte* Knothe, *supra*; Untermeyer *vs.* Freund, 1893 C. D., 664.)

Moreover, the idea of forming or decorating an article to represent or simulate a well-known object is not considered as proper food for the nourishment of inventive genius and a sufficient basis for the grant of monopolies, but is reserved among the rights and privileges common to all artists and artisans. (Bennage *vs.* Phillippi, 1876 C. D., 135; Foster *vs.* Crossin et al., 1891 C. D., 304.)

Novelty is essential to render a design patentable. Absolute identity of appearance, however, is not required to negative novelty. It will be sufficient if the anticipating design present a substantial similarity to the one in controversy. (Gorham Mfg. Co. *vs.* White, 14 Wallace, 511; *in re* Freeman, 1904 C. D., 619; *in re* Schraubstadter, 1906 C. D., 541.) Moreover, this similarity in appearance is to be determined with reference to its effect on the eye of the ordinary observer and not on that of an expert. (Macbeth-Evans Glass Co. *vs.* Rosenbaum Co., 199 F. R., 154-164; Gorham Mfg. Co. *vs.* White, *supra*.)

The last essential requisite to patentability in designs, to which I shall make reference, is that of originality. This may be disposed of by the statement that the word "original" as used in section 4929 of the Revised Statutes has the same meaning and effect as when used in connection with mechanical inventions.

In concluding this paper, I desire to emphasize the importance of the word "ornamental" as used in the design statutes. It is the one characteristic by which the field of the design patent is definitely distinguished from that of other patents. Moreover, a design which does not involve ornamental subject-matter of a substantial and meritorious character is not entitled to favorable consideration in this Office or in the courts.

April 29, 1915.